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Application Serial No. 09/767,633
Attorney Docket No. PC10721A

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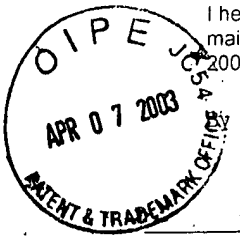

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(Signature of person mailing)
Raymond M. Speer, Reg. No. 26,810

(Typed or printed name of person)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: **JUDITH L. TREADWAY** :

APPLICATION NO.:**09/767,633** : Examiner:

FILING DATE: **JANUARY 23, 2001** : Group Art Unit: **1653**

TITLE: **METHODS OF TREATING DIABETIC CARDIOMYOPATHY USING GLYCOGEN PHOSPHORYLASE INHIBITORS**

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Commissioner for Patents
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Sir:

RESPONSE TO RESTRICTION REQUIREMENT

This is responsive to the Office Action mailed October 2, 2002 requiring restriction of Claims 1-11. A shortened statutory period for reply of one month from said mailing date has been set and a Petition for a Five-Month Extension of Time is attached whereby the period for response is extended to April 2, 2003.

Claims 1-11, all of the originally filed claims, are currently pending in the above-identified application. In the Office Action mailed October 2, 2002, the Examiner made certain restriction and election requirements. Applicant respectfully submits that the Examiner's restriction is unclear. This is so, because the Examiner has not provided a basis for restriction. In fairness, Applicant has attempted to respond to the restriction by interpreting the language in the most logical manner possible so as to create some restricted groups. If Applicant has misinterpreted the restriction he requests a further opportunity to respond to a more clear report. In summary, Paragraph 1, requires "[r]estriction to one of the following inventions", whereby the Examiner appears to require restriction to one invention selected from Groups "a.", "b.", "c.", and "d."

"Group a:" designates Claims 1, 3, 4, 8, and 9 and states that such claims link the inventions of Groups b.-d;

"Group b:" relates to Claim 2, which is directed to species falling within the scope of claims 1, 3, 4, 8 and 9;

"Group c:" relates to Claims 5-7, directed to certain subgenera of diabetic cadiomyopathy, and

"Group d:" relates to Claims 10-11 directed to certain subgenera combination compounds described in claim 9 of Group a.

Applicant elects with traverse the invention of Group a, Claims 1, 3-4 and 8-9.

Should Applicant have misinterpreted the Examiner's restriction and incorrectly identified Groups a-d, Applicant also hereby elects a species from claim 2, i.e. 5-chloro-1*H*-indole-2-carboxylic acid [(1S)-benzyl-3-((3R,4S)-dihydroxy-pyrrolidin-1-yl)-(2R)-hydroxy-3-oxo-propyl]-amide to continue prosecution.

Applicant traverses the Examiner's requirement on the grounds that it fails to establish any basis for requiring restriction. The Examiner has randomly assigned the claims to four separate groups without ever articulating a basis to distinguish the claims. Furthermore, the Examiner is under an obligation to present an argument to support the restriction, see MPEP 806.05 and 809.3. Applicant is at a loss to know where to begin to respond to the Examiner. It is unclear whether the Examiner is arguing that the claims are Independent, Species-Genus, Subcombination, Subcombination that is not Generic, Mutually Exclusive Characteristics, Distinct, Old Combination, Essential Subcombination, Subcombination Usable Together, or Related Inventions (See MPEP 803-810). The Examiner must give the Applicant some guidance.

Applicant also traverses the Examiner's restriction on the grounds that it is improper and an abuse of discretion because prosecution of the restricted subject matter in one application would not place a serious burden on the Examiner. M.P.E.P. § 803. According to M.P.E.P. § 803 the Examiner can only restrict patentably distinct inventions when (1) the inventions are independent or distinct as claimed **and** (2) where there is a serious burden on the Examiner if restriction is not required.

Applicant respectfully submits that the Examiner has made no showing that prosecuting the claims of the invention in one application would be burdensome. On the contrary, Applicant submits that prosecution of all of the claims in the same application would not be burdensome. This is so because the Examiner would be required to search the same class and subclass, in order to determine patentability of any of Groups a-d. Applicant respectfully refers the Examiner to page 2 of the Office Action, wherein the Examiner concedes that all of the claims would be classified in class 514, subclass 4. Applicant also respectfully traverses the Examiner's restriction of the species of claim 2 from the genus of glycogen phosphorylase inhibitors of claim 1. For the same reasons as discussed above, the Examiner has all the relevant art in front of him. No additional burden is imposed on the Examiner by prosecuting the species with the genus in a single application. Applicant specifically requests that the Examiner at least reconsider his restriction requirement and modify it so as to permit prosecution of claim 2 with claims 1, 3, 4, 8 and 9.

In accordance with the arguments set forth above, Applicant urges the Examiner to withdraw the restriction requirement and to proceed with the examination of all of the present claims.

Respectfully submitted,

Date: April 1, 2003

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